

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PETITION UNDER 37 C.F.R. §1.137(b) TO REVIVE AN UNINTENTIONALLY
ABANDONED APPLICATION

APPLICANTS: Bocionek et al. CONFIRMATION NO. 9465
SERIAL NO.: 09/994,184 GROUP ART UNIT: 2179
FILED: November 26, 2001 EXAMINER: Sara M. Hanne
TITLE: MEDICAL SYSTEM ARCHITECTURE WITH AN INTEGRATED
RIS CLIENT ON THE CONSOLE COMPUTER OF A
MODALITY

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

S I R:

The present application was held to be abandoned because Applicants' appeal was dismissed in a communication dated December 4, 2006. Preceding that communication, Applicants filed an Appeal Brief on June 30, 2006. That Brief was stated to be non-compliant in a Notice dated April 13, 2006. The reason for the non-compliance was stated in that Notice to be because the Brief did not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters. In a further note in that Notice, it was stated that the claimed subject matter should be a direct copy of the specification. In response, Applicants filed a revised Appeal Brief, wherein claim 1 was included with, Applicants believed, the requisite citations.

In the aforementioned communication dated December 4, 2006, it was stated that the appeal was dismissed because:

The summary of claimed subject matter fails to comply with Rule 41.37 in that it fails to give a concise explanation which clearly maps each limitation of the claims to the description of the specification by page

and line number and to the drawings by reference characters. For example this limitation in Claim 1 "...communication with said RIS client to allow transfer of images from said remote location to said processor via said RIS server...".

The application was held to be abandoned because there were no allowed claims.

Applicants question whether this action was appropriate, for two reasons. First, as noted above, the revised Appeal Brief did include a copy of claim 1 with citations to the specification and drawings. In view of the manner by which the original specification was written, it was Applicants' intent that the last citation at the end of claim 1 in the revised Appeal Brief be a citation for all of the language in the claim 1 from the preceding citation. Applicants had no reason to believe that the rules pertaining to the content of Appeal Briefs would be applied to require such precise parsing of the claim language as was stated in the communication dated December 4, 2006. If there was a disagreement as to whether the cited specification language in the revised Appeal Brief actually tracked the language of claim 1, or if there was discrepancy between the language of the claim and the language in the specification, this is an issue that, Applicants submit should have been addressed in the Examiner's Answer, since this is not a procedural issue but is actually a substantive issue as to claim interpretation and support in the specification under §112, first paragraph.

Moreover, even if it is determined to be appropriate to consider an Appeal Brief to be non-compliant for the above reason, Applicants submit the proper procedure would have been to issue another Notice of Non-Compliant Appeal Brief, rather than to dismiss the Appeal and abandon the application. This is particularly true in view of the fact that the requirement (if there is one) for such precise parsing of the claim language is based solely on an interpretation of the word "concise" in

37 C.F.R. § 41.37(c)(1)(v). To the best of the knowledge of the undersigned representative of the Applicants, the requirements associated with the interpretation of the word “concise” that is now being used by the Board of Patent Appeals and Interferences have been continually evolving and changing, and have not been published, at least as of the time of the dismissal of the Appeal. For example, in discussions with other Examiners in connection with other appeals subsequent to the present Appeal, the undersigned representative of the Applicants has learned that the term “concise” is now being interpreted to mean that *only* the independent claims on appeal should be included, with citations, in the section entitled Summary of Claimed Subject Matter, and no other material. The revised Appeal Brief accompanying the present Petition thus conforms to that interpretation, and further citations have been added in claim 1 as well to respond to the statements in the Communication dated December 12, 2006.

The revised Appeal Brief submitted herewith therefore conforms in all respects to the requirements of 37 C.F.R. § 41.37, and thus constitutes a reply in satisfaction of 37 C.F.R. § 1.137(b)(1).

This Petition is accompanied by electronic payment in the amount of \$1,540.00 for the petition fee required by 37 C.F.R. § 1.17(m), in satisfaction of 37 C.F.R. § 1.137(b)(2). For the above reasons, however, Applicants submit that the dismissal of the Appeal and the holding of abandonment were improper, and therefore if a determination is made that this is the case, Applicants request a refund of the petition fee in the amount of \$1,540.00, and request that the refund be credited to Deposit Account No. 501519.

In satisfaction of 37 C.F.R. §1.137(b)(3), Applicants state that the entire delay in filing the required reply from the date for the reply until the filing of a grantable Petition pursuant to that paragraph was unintentional.

In satisfaction of 37 C.F.R. §1.137(b)(4), a Terminal Disclaimer is also submitted herewith, accompanied by electronic payment in the amount of \$130.00 for the fee required by 37 C.F.R. §1.20(d). For the reasons stated above, however, Applicants submit that the dismissal of the Appeal and the holding of abandonment were improper, and, if this is determined to be the case, then Applicants request that the accompanying Terminal Disclaimer be disregarded and not made effective to reduce the term of this patent, and Applicants under those circumstances also request a refund in the amount of \$120.00, and request that this refund be credited to Deposit Account No. 501519.

All conditions of 37 C.F.R. §1.137(b) having been satisfied, revival of the present application is proper, and the same is respectfully requested.

Submitted by,



(Reg. 28,982)

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